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10/700,146	11/03/2003	Nathan Kane	TP15024USNP	3839

27777 7590 11/26/2007  
PHILIP S. JOHNSON  
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ONE JOHNSON & JOHNSON PLAZA  
NEW BRUNSWICK, NJ 08933-7003

EXAMINER
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GORDON, BRIAN R

ART UNIT	PAPER NUMBER
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1797

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11/26/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/700,146

Applicant(s)

KANE ET AL.

Examiner

Brian R. Gordon

Art Unit

1743

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 5-37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☒ Claim(s) 4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Applicant's election without traverse of Group I in the reply filed on August 22, 2007 is acknowledged.
2. Claims 5-37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  
  
The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 2 lists steps (a)-(f) it is unclear where these steps occur relative to the previously recited steps (a)-(d) of claim 1. Furthermore step (d) of claim 2 refers to step (c) however it is unclear which step (c) is being referenced.

It should be noted that the term "or" makes step (f) optional not required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by  
Nanthakumar et. al., US 7,159,740.

Nanthakumar et. al. disclose a power transfer device (column 4, line 29). The reference discloses the method as claimed. Once the resin reservoir 1540 is in position underneath the skimming plate 1530, and the array 1506 is in position over the skimming plate 1530, the array 1506 is pneumatically or hydraulically lowered along the Z axis. Vertical displacement shafts 1630 on the dispensing assembly 1508 slide vertically into vertical displacement bores 1632, thus allowing the array 1506 to drop vertically. This allows the hollow tubes 1802 to slide through the holes of the skimming plate 1530, and into the resin reservoir 1540, filling the distal ends of the tubes 1802 with resin. The force of lowering the array 1506 into the reservoir 1540 pushes resin particles up into each of the hollow tubes 1802. The friction between particles after they have been pushed into the tubes 1802 holds the particles within the tubes as the array 1506 is moved out of the resin reservoir 1540. The resin particles also become frictionally engaged with the inner surfaces of the hollow tubes 1802 (as shown in more detail in FIG. 20C) (column 22, lines 44-60).

FIG. 20A is a schematic representation of the lower portion of one hollow tube 1802. A solid plunger 1804 moves up and down within the hollow tube 1802, and is shown in FIG. 20A in its most upward position. At this raised position, it should be apparent that the volume of resin particles that will be picked up in the tube is defined

by the internal tube volume from the bottom 1807 of the plunger 1804 to the open end 1803 of the hollow tube 1802, represented by the portion designated by the brackets 1806. After the hollow tube array is lowered toward the MTP 1504 and is in position over the MTP wells, the plungers 1804 will be lowered, so they push out all the contents (resin particles) contained in the tube 1802, out and into a corresponding well of the MTP 1504. This is illustrated in FIG. 20B, which depicts the plunger 1804 pushed down to its farthest downward location. Alternatively, the hollow tube 1802 can be raised and moved upward in relation to the plunger 1804 rather than the plunger 1804 being lowered. In any case, the plunger 1804 pushes the resin particles 1820 out of the space 1806 (column 25, lines 24-43).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nanthakumar et. al. as applied to claims 1-2 above, and further in view of Hatcher et al. US 7,179,420.

Nanthakumar et al. does not disclose the size of the particles.

Hatcher et al. discloses a particle dispensing method and device. It is disclosed that the device maybe used to dispense various particles of various sizes such as microshperes for combinatorial chemistry. With appropriate detection equipment, it is expected that particles as small as about 1 micron can be detected (column 4, line 32-33).

It would have been obvious to one of ordinary skill in the art at the time of the invention to recognize the particles transferred in the process of Nanthakumar may be less than 200 micrometers.

***Allowable Subject Matter***

11. Claim 4 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record does not teach nor fairly suggest the further steps of claim 4, such as those directed to the forming the powder bed in the manner claimed.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gard, Douglas J. et al.; Zarowitz, Michael A. et al.; Nanthakumar, Elizabeth et al.; Yarborough, Cody L. et al.; Carlson; Eric et al.; Vann; Charles S. et al. ; Chandler; Howard M.; and Smith; John L. et al. disclose power transfer methods.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian R. Gordon whose telephone number is 571-272-1258. The examiner can normally be reached on M-F, 1st Fri. Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on 571-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Brian R Gordon  
Primary Examiner  
Art Unit 1743

brg

A handwritten signature in black ink, appearing to read 'B. R. Gordon', with a long horizontal flourish extending to the right.